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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,178	06/04/2001	Lee M. Greenberg	53914	8075

7590 11/28/2005

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EXAMINER

NUTTER, NATHAN M

ART UNIT PAPER NUMBER

1711

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/874,178

Applicant(s)

GREENBERG ET AL.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

This application has been re-assigned to Examiner Nathan M. Nutter in Art Unit 1711. All inquiries regarding this application should be directed to Examiner Nutter at telephone number 571-272-1076.

#### ***Specification***

The Specification must be amended at page 1, first full paragraph, to reflect the proper continuing data.

#### ***Response to Amendment***

In response to the amendment filed 14 June 2004, the following is being placed in effect.

The rejection of claims 2, 7 and 8 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention, is hereby expressly withdrawn.

The rejection of claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 5,910,514, is hereby expressly withdrawn in view of the timely filed Terminal Disclaimer.

The rejection of claim 8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5 and 6 of U.S. Patent No. 5,910,514 in view of Byrne (US 5,396,731), is hereby expressly withdrawn.

The following grounds of rejections are being maintained or are newly presented.

#### ***Claim Objections***

The recitation in claim 3 at line 1 of "said coating is comprises (sic)" is not proper English.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for rubber, does not reasonably provide enablement for “natural polymers and synthetic high polymers.” The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The Specification alludes to “natural polymers and synthetic high polymers” at page 4, second full paragraph, but fails to provide any guidance for what is intended or as how the constituents are combined.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation of “high polymers” at line 4 of claim 1 renders the claims as vague and confusing since the term “high” does not define polymers in any manner that clearly shows what is contemplated thereby. The term is relative and not definitive.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne (US 5,396,731), previously cited.

The patent to Byrne (US 5,396,731) teaches the production of a synthetic mulch pad that may comprise rubber granules and buffings, a binder that may comprise polyurethane and colorants. Note column 2 (lines 50-58) for the resin binder. Note column 4 (lines 53-63) for the constituents and their compositional limitations which clearly embrace those recited and claimed herein. Note column 4 (lines 39-53) for the colorants, including the pigments of claim 3.

While it is true that Byrne is directed to a flexible mulch pad, it would still be obvious to one of ordinary skill in the art to use the above composition of Byrne to prepare the herein claimed synthetic mulch. The compositions are essentially identical, only final forms differ. Furthermore, since Byrne mixes all above ingredients in a container, it is obvious that the resin and colorant form a coating on the rubber granules.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Coffey (US 2002/0119314), newly cited.

The reference to Coffey (US 2002/0119314) teaches the manufacture of "colorized rubber" particles, useful as soil agents that may be used in playgrounds as a mulch, wherein rubber particles, ground from used tires into desired shapes and sizes, may be coated with a binder and pigment, as recited and claimed herein. Note the Abstract, paragraphs [0002], [0003], [0007] and [0010] for the broad concept. At paragraph [0014] the reference teaches the resins that may be employed as the binder including polyacrylates of claim 7 and polyurethanes of claim 8. the sizes are shown at paragraph [0023]. The pigments are taught at paragraphs [0024] et seq. and the particular weight percents of constituents are shown at paragraph [0015], as claimed herein. Further, note paragraphs [0038] and [0040] and the Examples.

Although the reference does not specifically teach the composition as a mulch for plants, the employment on soil is shown, and compared to the use of mulch in the identical locations. As such, and since there are no unexpected or surprising results, the instant claims are deemed to be at least obvious, if not anticipated, by the teachings of the reference.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Coffey (US 2002/0128366), newly cited.

The reference to Coffey (US 2002/0128366) teaches the manufacture of "colorized rubber" particles, useful as soil agents that may be used in playgrounds as a mulch, wherein rubber particles, ground from used tires into desired shapes and sizes, may be coated with a binder and pigment, as recited and claimed herein. Note the Abstract, paragraphs [0003], [0004], [0008] and [0012] for the broad concept. At paragraph [0019] the reference teaches the resins that may be employed as the binder including polyacrylates of claim 7. The contemplated sizes of the product are shown at paragraph [0024]. The pigments are taught at paragraphs [0024] et seq. and the particular weight percents of constituents are shown at paragraph [0013], as claimed herein. Further, note paragraphs [0042] and [0044] and the Examples.

Although the reference does not specifically teach the composition as a mulch for plants, the employment on soil is shown, and compared to the use of mulch in the identical locations. As such, and since there are no unexpected or surprising results, the instant claims are deemed to be at least obvious, if not anticipated, by the teachings of the reference.

### ***Response to Arguments***

In response to applicant's arguments, the recitation "sized, shaped, and colored to imitate natural mulch" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight

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where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The reference to Byrne (US 5,396,731) teaches a "mulch." The step from pad to powder is deemed to be obvious, shown especially by that particular word's use (mulch), and has not been shown to be of particular significance since the composition of the reference performs the identical function as recited and claimed herein.

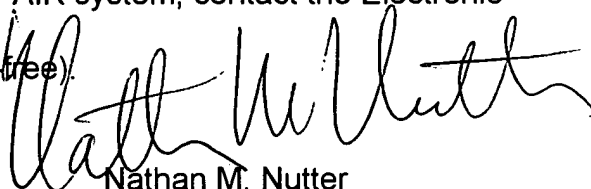
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Nathan M. Nutter', is written over the printed name and title.

Nathan M. Nutter  
Primary Examiner  
Art Unit 1711

nmn

18 November 2005